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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,885	11/16/2001	Myriam Mellul	216172US0REISSUE	7554
22850	7590	09/20/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER

1615

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/987,885

Applicant(s)

MELLUL ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 34-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32, 34-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Receipt is acknowledged of amendment, extension of time filed on 6/22/04. Claim 33 has been canceled and claims 57-78 have been added as per applicant's amendment dated 6/22/04. amendment does not conform to 1.173 (b-d). Applicants need to resubmit the claims. Claims 1-32 and 34-78 are pending in the application and the status of the application is as follows:

#### *Reissue Applications*

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,985,297 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

2. The reissue oath/declaration filed with this application is defective because the error, which is relied upon to support, the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

3. Applicants state in the reissue declaration the specific error, as "claims of U. S. Patent No. 5,985,297 are insufficient in their description of our invention since they omit preferred embodiment". **Applicants are notified that the declaration does not state a specific error, i.e. what the preferred embodiment is or may be.**

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4. Claims 1-32, 34-78 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

5. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Response to Arguments***

6. Applicant's arguments filed 6/22/04 have been fully considered but they are not persuasive.
7. Applicants argue that statement of specific error is not required and point out to MPEP 1414, page 1400-23.
8. Contrary to applicant's statement, the MPEP requires specific error. See the paragraph reproduced below which is from MPEP 1400-29, Rev.2, May 2004.

**A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE).**

*Applicant need only specify in the reissue oath /declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath /declaration is satisfied. Applicant may specify more than one error. Where more than one error is specified in the oath /declaration and*

*some of the designated "errors" are found to not be "errors" under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue. The "at least one error" which is relied upon to support the reissue application must be set forth in the oath /declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the next Office action. All that is needed for the oath /declaration statement as to error is the identification of "at least one error" relied upon. **In identifying the error, it is sufficient that the reissue oath /declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid.** The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath /declaration. If the initial reissue oath /declaration "states at least one error" in the original patent, and, in addition, recites the specific corrective action taken in the reissue application, the oath /declaration would be considered acceptable, even though the corrective action statement is not required.*

*(C) It is not sufficient for an oath /declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." **Rather, the oath /declaration must specifically identify an***

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**error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See In re Constant, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.**

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 18-32 and 34-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **New matter rejection.**

There is no support in the patent 5,985,297 for the expressions “**Volatile oil**” or **volatile component**”. The support in the patent is for “**volatile silicone oil**”.

There is no support in the patent for the species claims 23 and 43 where in **n=0**. The support in the patent is for **n=2300 or n=2700**.

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*Response to Arguments*

11. Applicant's arguments filed 6/22/04 have been fully considered but they are not persuasive.

12. Applicants submit a is a copy of PCT application publication no. 96/19185, and point out that the PCT application discloses lip compositions containing dimethicone oils and the compositions can optionally contain volatile oils. (Pages 4-5) and the PCT application indicates that either **volatile hydrocarbon oils** such as isododecane or **volatile silicone oils** such as cyclomethicone **can be combined interchangeably** in the disclosed compositions containing dimethicone oil (Page 5) and **argue that** the present specification states that oil should be present in the invention compositions, and exemplifies compositions containing both silicone and non-silicone oils, and applicants' disclosure of volatile silicone oil, by itself is sufficient to support the phrase "volatile oil" based upon the disclosure of PCT application.

13. It is the examiners position that, volatile silicone oils belongs to the broad genus of volatile oils. Volatile oils can be volatile hydrocarbon oils for which there is no support in the patent '297. Applicants cannot rely on PCT application just because PCT application is claiming priority date of the provisional application which date is closer to the filing of the instant application. The patent does not convey to one skilled in the art at the time the application was filed that they were in possession of the subject matter drawn to **" 10 to 90% of at least one volatile oil "**. **Therefore the new matter rejection is deemed proper.**

Applicants argue that the recitation of  $n=0$  is not new matter for the species claims 23 and 43 and point out to col.2, lines 34-48 of patent which states that " n and p may have values

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preferable ranging from 0-5000 and more preferably ranging from 0 to 3000” and state that this concept supports the species claims which recite  $n=0$ .

In response to the above argument, it is the position of the examiner that applicants are claiming species where in R1-R6 are methyl and  $p=0$  or  $n=0$ . The patent at col.2, lines 40-55 describe the species where in  $p=0$  and  $n$  has to be either 2300 or 2700. The patent indeed states at col.2, line 38 that  $n$  and  $p$  can be between 0-5000 or 0-3000. This applies to the genus of formula at col.2. Description for the genus does not support description for the specific species. Therefore the new matter rejection is maintained.

The following new grounds of rejection are necessitated by the amendment.

***Claim Rejections - 35 USC § 112***

14. Claims 57-78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

There is no support in the patent for the species of claims 57 and 58 where in  $p=0$  and  $n$  can be any integer from 0-5000 for the species. Note that the support in the patent is for  $p=0$  and  $n$  can be either 2700 or 2300.

There is no support in the patent for “A cosmetic composition comprising from 2% to 50% of at least one silicone gum, **at least one silicone-containing component**, from 0.5% to 15% of at least one pigment, and from 0 to 30% of at least one filler “.



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The support in the patent is for “A cosmetic composition comprising from 2% to 50% of at least one silicone gum, from 10% to 90% of at least one silicone oil, from 0.5% to 15% of at least one pigment, and from 0 to 30% of at least one filler”.

The “silicone –containing component” includes silicone oil, silicone gum, siloxy silicates, and silicone resins. There is no support in the patent for “ siloxy silicates, silicone resins, fumed silica” . All these compounds are “ silicone-containing components” . The specification clearly teaches to one skilled in the art that applicants were in possession of the subject matter drawn to cosmetic composition having the four main components with specific ranges. This corresponds to claim 1 allowed in the patent.

15. Claims 59 and 78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 78 is duplicate of claim 59.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

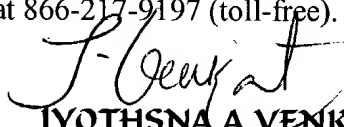
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JYOTHSNA A VENKAT**  
Primary Examiner  
Art Unit 1615

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